

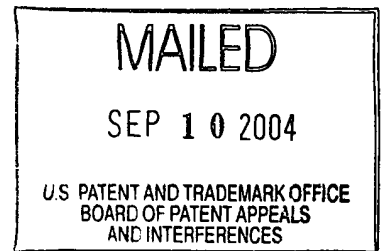
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte CAROLYN JEAN CUPP,  
LYNN ANN GERHEART, SCOTT SCHNELL,  
SHERI LYNN SMITHEY and DONNA ELIZABETH ANDERSON



Appeal No. 2004-1633  
Application No. 09/154,646

HEARD: January 07, 2003

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

DECISION ON APPEAL

PER CURIAM

This appeal was taken pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-24.<sup>1</sup>

Appellants' invention relates to a pet food product and a method of administering the product to a pet. A further

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<sup>1</sup> The examiner now maintains that claims 4, 5, 8-12, 16 and 21-23 are either allowed or objected to (dependent claims free of the prior art). See, e.g., pages 2-4 of the Supplemental Examiner's Answer (Paper No. 23). Thus, the rejections pertaining to those claims have been withdrawn by the examiner.

understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A dried pet food comprising a matrix comprising a denatured protein source, a gelatinized carbohydrate source, at least 2% by weight insoluble fiber, a humectant in an amount sufficient for reducing brittleness of the matrix; and  
the dried pet food having a moisture content of less than 10% by weight.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Simone et al. (Simone)                      5,407,661                      Apr. 18, 1995

Claims 1, 13, 20 and 24 stand rejected under 35 U.S.C. § 112, first paragraph as lacking descriptive support in the application as filed. Claims 1-3, 6, 7, 13-15, 17-20 and 24 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Simone.

#### DECISION

This merits panel of the Board reverses the examiner's § 112, first paragraph rejection of claims 1, 13, 20 and 24. In contrast, the § 102 rejection of claims 1-3, 6, 7, 13-15, 17-20 and 24 over Simone is sustained with Judge Kratz and Judge Smith voting to affirm and Judge Waltz voting to reverse. Moreover, pursuant to the provisions of 37 CFR § 1.196(b), this panel of

the Board enters a new ground of rejection of claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Simone, albeit Judge Smith joins that new ground of rejection only in so far as claims 4, 5, 8-12, 16 and 21-23, which have been indicated as free of the prior art or objected to by the examiner (supplemental answer, page 4) are included therein.

#### Other Issue

Prior to the final disposition of this application, the examiner should determine whether or not any of the claims of this application would be subject to an obviousness-type double patenting rejection over any of the claims of related copending application No. 10/052,949.

#### Conclusion

In sum, the decision of the examiner rejecting claims 1, 13, 20 and 24 under 35 U.S.C. § 112, first paragraph as lacking descriptive support in the application as filed is reversed; and, the decision of the examiner rejecting claims 1-3, 6, 7, 13-15, 17-20 and 24 under 35 U.S.C. § 102(b) as being anticipated by Simone is affirmed. Also, a new ground of rejection is introduced against claims 1 through 24 under 35 U.S.C. § 103(a) over the teachings of Simone. Further details of this panel's majority position for the decided matters, including the

introduction of a new ground of rejection is set forth below in the separate opinion of Judge Kratz and the concurring portions of the separate opinions of Judge Waltz and Judge Smith.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that new grounds of rejection shall not be considered final for purposes of judicial review.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter considered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of

Patent Appeal and Interferences upon the same  
record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or § 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

The separate opinions of Judge Waltz, Judge Kratz and Judge Smith follow.

AFFIRMED/37 CFR § 1.196(b)

KRATZ, Administrative Patent Judge:

Upon consideration of the opposing arguments and evidence presented on appeal, it is my judgement, concurred with, in each case, by a majority of the panel, that the examiner's § 102(b) rejection should be affirmed, the examiner's § 112, first paragraph rejection should be reversed, and a new ground of rejection under § 103(a) of all of the claims pending in the application be introduced pursuant to the provisions of 37 CFR § 1.196(b).

Rejection under 35 U.S.C. § 112, first paragraph

With regard to written descriptive support, all that is required is that appellants' specification reasonably conveys to one of ordinary skill in the art that as of the filing date of the application, appellants were in possession of the presently-claimed invention; how the specification accomplishes this is not material. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Edwards, 568 F.2d 1349, 1351-2, 196 USPQ 465, 467 (CCPA 1978).

"[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

"Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Concerning claims 1, 13, 20 and 24<sup>2</sup>, the examiner (answer, page 3) urges that:

Appellants' amendment of October 20, 2000, introduced new matter to the claims in the form of the phrase "at least 2% by weight insoluble fiber", which is not supported by the teachings of the original specification. It is noted that the specification and previous claims support language directed to "about 2% to about 15% by weight insoluble fiber", but not any random amount above "at least 2%".

Appellants maintain that the original application disclosure of the "about 2% to about 15% by weight insoluble fiber" range was presented as a convenient or preferable insoluble fiber content range at pages 3 and 4 of the specification and not as an absolute requirement. In this regard and as evidenced by originally filed claims 1, 13 and 20 and page 2 of the specification as filed, it is manifest that insoluble fiber is recited as an ingredient of the claimed pet food without limiting the weight percent amount thereof.

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<sup>2</sup> It is not clear why the examiner excluded claims that include the same "unsupported" limitation by way of their dependency on the rejected claims from the rejection. That error is harmless because the stated rejection is reversed.

The examiner's position seems to be that the preferred weight percent range recited in the original specification should be regarded as furnishing the absolute upper limit of about 15% insoluble fiber as being a requisite requirement for the claims together with a lower limit of about 2% because that is the broadest range of numbers provided for the insoluble fiber content of the pet food.

The examiner's argument is not persuasive. As correctly noted by appellants, the use of insoluble fiber as an ingredient in the pet food without the restraint of a specific numerical lower or upper weight percent limit is clearly conveyed by original claims 1, 13 and 20. Moreover, the use of about 2 to about 15 weight percent insoluble fiber is also disclosed as preferred. Given both of those disclosures, the examiner has not met the burden to establish that the here claimed "at least 2% by weight insoluble fiber" limitation would have been construed as describing possession of a new concept or invention not conveyed by the original disclosure simply because 2% rather than about 2% is recited as a lower limit and/or because about 15 weight percent is not recited as the upper insoluble fiber content limit. While it is recognized that no upper limit for the weight percent is recited in the rejected claims, the use of amounts of



insoluble fiber without the restraint of an upper numerical weight percent limit would have been conveyed by the original disclosure to one of ordinary skill in the art as noted above.

Consequently, this panel of the Board reverses the examiner's stated rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102(b)

At the outset, it is noted that appellants state that they "argue for the separate patentability of each of the independent claims" (brief, page 7) and do not identify the dependent claims as being argued separately. However, in the Argument section of the brief, appellants argue the rejected claims together in asserting that the examiner's § 102 rejection over Simone is in error as noted by the examiner in the answer (page 2, item No. 7). Nor are separate arguments presented for the remaining rejected claims in the reply briefs. Accordingly, we select claim 1 as representative of rejected claims 1-3, 6, 7, 13-15, 17-20 and 24 and this appeal is decided as to the examiner's § 102(b) rejection on the basis of that representative claim. See 37 CFR § 1.192(c)(7) and (c)(8)(2000) and In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("if the

brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim").

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

However, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

In the present case, the examiner has reasonably determined that the appealed claims read on the subject matter described by Simone. In this regard, it is noted that appellants essentially

do not argue against the examiner's factual determinations concerning the correspondence of the product described in Simone and that of representative claim 1 but for the claimed moisture content range for the pet food product.<sup>3</sup> Concerning this matter, Simone discloses a dried pet food product including a protein source such as gelatin (which by definition due to the gelled state thereof is a denatured protein), carbohydrate, insoluble fiber in amounts greater than 2% by weight as determined by the examiner<sup>4</sup> and a humectant in effective amounts as claimed. See,

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<sup>3</sup> While appellants seem to have suggested in their brief that Simone is not directed to a pet food as claimed, it is clear that the pet chew of Simone is disclosed as being an edible product. Thus, such commentary in the briefs is not considered persuasive in generating an issue as to an alleged product difference other than the focused upon and argued moisture content difference between Simone and representative claim 1. In addition, it is observed that appellants do not argue that Simone's protein source (collagen or gelatin) is not a denatured (chemically or physically unaltered) protein.

<sup>4</sup> The examiner asserts that the insoluble fiber content disclosed in Simone would be approximately 18-20 weight percent when using corn cobs in a 20-50 weight percent range dry weight basis range as Simone discloses. Concerning this matter, it is noted that Kent (page 305), attached to appellants' reply brief, indicates that about 40 percent of corn cob material is pentosans, 15 percent lignin and 35 percent cellulose. The examiner's calculation seems to assume about a 90 weight percent insoluble fiber content in the corn cob material and does not take into account that appellants' representative claim 1 does not specify the insoluble fiber content on a dry weight basis. In any event, appellants do not argue that Simone discloses an insoluble fiber content that is outside the embrace of representative claim 1.

e.g., column 2, lines 59-66, column 3, line 18 through column 4, line 8 and column 5, lines 11-18 of Simone.

In applying Simone as an anticipatory reference, the examiner maintains the position that the reference disclosure of "about 10 to about 30% by weight" (column 5, lines 65-68) in describing moisture levels meets the claimed limitation of "a moisture content of less than 10% by weight" for the pet food product. See, e.g., claim 1 and pages 4 and 5 of the answer.

Appellants, on the other hand, contend that the pet chew moisture content disclosure of Simone makes it clear that a moisture content embraced by the here claimed less than 10% by weight is not described in Simone. Consequently, the pivotal issue developed in this appeal concerning the examiner's § 102(b) rejection is whether the disclosure of an about 10 to about 30 percent by weight moisture level by Simone (column 5, lines 65-68) would reasonably convey to one of ordinary skill in the art that Simone described or had possession of a pet chew that includes a moisture content of less than 10 weight percent. We answer that question in the affirmative.

Here, a majority of this merits panel determines that Simone's disclosed range of about 10 to about 30 weight percent moisture content provides a description of an edible chew product

employing about 10 percent moisture content. In other words, it has been found that the description of a moisture content range of about 10 to about 30 weight percent in Simone is such that one of ordinary skill in the art would have recognized that Simone was in possession of a pet chew having an about 10 percent by weight moisture content. Moreover, a majority of this panel finds that the term "about" as used in the about 10 percent disclosure of Simone would have been understood by one of ordinary skill in the art as a description that permits some variance both above and below an absolute value of 10 percent moisture levels in the pet chew, such as, for example, a pet chew having a moisture level of 9.99%. Consequently, a majority of this merits panel has determined that the disclosure of Simone would have conveyed to one of ordinary skill in the art that Simone had possession of a pet chew including a discrete amount of moisture less than 10 weight percent. It follows that described in Simone is an amount of moisture in the pet chew that is a complete description and, thus, an anticipation of the claimed moisture content range of representative claim 1. See Ex parte Lee, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993). Of course, it is well settled that the disclosure in the prior of art of any value within a claimed range is a complete description

of the claimed range. See In re Wertheim, 541 F.2d 257, 267, 191 USPQ 90, 100 (CCPA 1976). Also, see Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945-46 (Fed. Cir. 1999). (determining that a prior art disclosure of "33-80%" or "50-70%" constitutes a description of "60-90%" in a claim).

Appellants make much of the examples and other disclosures in Simone wherein preferred moisture levels above 12 weight percent and/or where an intermediate product moisture level of about 10 to about 35 weight percent are disclosed. However, those other portions of the disclosure of Simone do not furnish evidence that would detract from Simone's description of a final product moisture level of about 10 to about 30 weight percent moisture as relied upon by the examiner. After all, it is well settled that the disclosure of a reference is not limited to preferred or exemplified embodiments but rather includes all embodiments described therein. Also, it should be observed that appellants' representative claim 1 does not exclude a stable intermediate pet chew product that is in a state prior to final drying and/or other processing. Furthermore, the fact that Simone discusses an advantage in imparting flexibility to the chew product by using a moisture content level above 12 weight

percent does not serve to negate the other disclosures of Simone describing a lower moisture content as discussed above.

Appellants maintain that Simone is a non-enabling reference for a moisture content less than 10 weight percent. However, Simone (U.S. Patent No. 5,407,661) is presumed to be an enabling for that all that is disclosed therein. Appellants have not furnished any evidence or scientific reasoning to substantiate their view of Simone's U.S. patent and that would refute that reasonable presumption that Simone is enabling for the subject matter disclosed therein.

In light of the above, a majority of this panel of the Board has determined that the examiner's § 102(b) rejection of representative claim 1 over Simone is sustainable. It follows that, on this record, the examiner's § 102(b) rejection of claims 1-3, 6, 7, 13-15, 17-20 and 24 over Simone is affirmed.

#### New Ground of Rejection

Claims 1-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Simone. As discussed above, Simone discloses a dried pet food product including a protein source such as gelatin (which, as a result of the gelled state thereof is, by definition, a denatured or altered protein), carbohydrate,

insoluble fiber, including cellulose, in an amount that is reasonably suggestive of greater than 2% by weight amounts, and a humectant in an amount that corresponds to the effective amount required by claim 1. See, e.g., column 2, lines 59-66, column 3, line 18 through column 4, line 8 and column 5, lines 11-18 of Simone. Simone also teaches that the pet food chew can have a moisture content of "about 10 to about 30% by weight" (column 5, lines 65-68), which represents an amount of moisture that overlaps or at least abuts the claimed amount of less than 10 weight percent moisture as recited in claim 1. Consequently, the subject matter of claim 1 is prima facie obvious over the teachings of Simone as those teachings would have been understood by one of ordinary skill in the art at the time of appellants' invention. See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990) (concluding that a claimed invention was rendered obvious by a prior art reference whose disclosed range was about 1-5% carbon monoxide whereas the claimed range was more than 5% to about 25% carbon monoxide); and In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974) (concluding that a claimed invention was rendered prima facie obvious by a prior art reference whose disclosed range



(0.020-0.035% carbon) overlapped the claimed range (0.030-0.070% carbon)).

Additionally, Simone (column 2, line 59 through column 5, line 18) teaches that the fibrous component, the humectant, the starch material, and the protein binder material as well as the moisture content are all result effective variables. For example, the cellulosic fibrous material is disclosed, inter alia, as having a mechanical cleansing function when the product is chewed by an animal and helps to impart flexibility and resiliency to the product chew of Simone. The starch ingredient is taught by Simone to function as an expansion medium and matrix superstructure for suspending oral care additives, including the fibrous particles. Simone teaches that the protein binder adds to the product's flexible texture besides serving as a binder. Humectant is used by Simone to enhance the flexible texture and moisture retention properties of the product. Moreover, Simone suggests that the product has a flexible (chewy) and non-brittle texture, which enhances the teeth cleaning benefits of administering such a product to an animal as a food product. See, e.g., column 5, lines 26-38 of Simone. Moisture is also disclosed by Simone as a flexibility enhancing ingredient.

Thus, Simone would have led one of ordinary skill in this art to manufacture an edible pet food chew with an amount of each ingredient as claimed herein, including moisture amounts as claimed, based on the properties desired for the resultant extruded product. After all, discovering the optimum or workable ranges from the general description of limited ranges for the finite number of variables taught by Simone through routine experimentation is within the ambit of one of ordinary skill in the art. See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In this regard, we also note that Simone describes the claimed product at column 2, lines 38-66 of the patent without any limitation as to the amount of each ingredient. The ingredient amounts referred to in other portions of the preferred embodiments section of the patent represent the preferred amounts of each ingredient, not the only workable amounts of each ingredient that Simone would have suggested to one having ordinary skill in the art. After all, the applied patent may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art.

In light of the overlap in the amount of humectant recited in claim 2 and that taught by Simone, the claimed amount would

have been fairly suggested to one having ordinary skill in the art by Simone. Concerning claim 3, Simone (column 5, lines 11-14) teaches that glycerine is a preferred humectant. Concerning claim 5, Simone (column 3, lines 3-34) teaches the use of cellulose.

Concerning claim 4, Simone discloses a preferred range for the amount of cellulose, supplied as corn cob fractions, that is slightly above the range of insoluble fiber required by claim 4. However, not all of the corn cob fraction represents insoluble fiber. Moreover, Simone excludes moisture in reporting the dry weight basis for the percentage amount of corn cob fractions that are disclosed as preferred. Given Simone's disclosure of the result effectiveness of the cellulose fiber component as discussed above, Simone reasonably would have suggested to one of ordinary skill in the art that using an amount of corncob fraction or other cellulose material that would have resulted in an insoluble fiber content between 2-15% by weight of the product including the moisture content thereof would result in obtaining a product with a workable amount of fiber therein.

Although the ranges of the claimed and prior art preferred insoluble fiber contents (claim 4, for example) may not overlap, they are close enough such that one skilled in the art would have

expected them to produce the same or similar results. See  
Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773,  
779 (Fed. Cir. 1985).

While Simone does not report the density of the product made, Simone does employ ingredients that correspond to those claimed herein. Also, like appellants, Simone employs an extrusion method for forming the product chews. Appellants refer to the suitability of an extruder obtained from Wenger Manufacturing, Inc. at page 5 of their specification and Simone describes a Wenger TX-52 machine at column 7, lines 53-63 of the patent. Based on the extensive commonalities between appellants' product and that of Simone, we determine that one of ordinary skill in the art would have reasonably arrived at a product having a density as specified in appellants' claim 6 by following the teachings and suggestion furnished by Simone with a reasonable expectation of success in so doing.

Concerning claim 7, Simone teaches that their product is for animals and refers to pets, including cats and dogs, in the background section of the patent. Moreover, Simone (column 7, lines 22-28) discloses products that have 0.25 to 0.75 inch diameters, which are cut into 1-5 inch sections as one typical product that may be made. That disclosure of Simone is reasonably

suggestive of a product that exceeds the minimum dimensions set forth in claim 7.

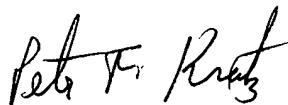
In light of the above discussion, Simone would have reasonably suggested products having the combination of ingredients and specified amounts thereof as required by claims 8-10 as well as the density or size, respectively, as specified in claims 11 and 12. Similarly, the combination of ingredients, product density and size of claims 13-18 is reasonably suggested by Simone based on the above discussion. Concerning claim 19, the commonalities between the product of Simone and appellants' product as discussed above, would have reasonably suggested that a probe test of the product of Simone would yield similar results to those reported in claim 19 for appellants' product.

Regarding the methods of claim 20 and 24, Simone (column 1, lines 18-31 and column 2, lines 38-55) teaches that a product corresponding to that claimed herein can be administered to an animal to reduce plaque, stain and tartar buildup on an animal's teeth. Consequently, one of ordinary skill in the art would have been led to a method of administering to a cat or dog a product that corresponds to the product administering step as recited in claims 20 and 24 with a reasonable expectation of success in carrying out such a method.

Concerning the about 3%-7% moisture content recited in claims 21-23, one of ordinary skill in the art would recognize that the about 10% moisture content lower limit for the range of moisture content set forth in the preferred embodiments section of Simone merely represents a preferred lower limit for the moisture content, not an absolute limit. Moreover, the term "about" suggests some variability in that preferred lower limit. Also, the term "about 7%" employed by appellants as an upper limit for moisture indicates that claims 21-23 do not preclude moisture levels somewhat above an absolute 7% moisture content. In this regard, it is further observed that Simone (column 5, lines 5-9 and 44-54) teaches that higher moisture contents for the chew products have drawbacks (mold, bacteria and yeast formation and growth) as well as advantages (advantageous in imparting flexibility). Given that disclosure, it is reasonable to expect that one of ordinary skill in the art in testing the limits of moisture for flexibility and for disadvantageous mold, bacteria or yeast growth would have been reasonably led by Simone to employ a lower moisture content within the range recited in claims 21-23 where the disadvantages of otherwise suppressing mold, bacteria and yeast growth via the addition of suppressant additives would outweigh any flexibility reduction at those lower

moisture levels. In this regard, it is again noted that Simone does not express an absolute lower limit for moisture, just a preferred embodiment lower limit for moisture.

Consequently, on this record, we determine that one of ordinary skill in the art at the time of the invention would have found subject matter embraced by claims 1-24 as being prima facie obvious based on the teachings of Simone.



PETER F. KRATZ  
Administrative Patent Judge

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) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES

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JEFFREY T. SMITH, Administrative Patent Judge, concurring:

I concur that the subject matter of claims 1-3, 6, 7, 13-15, 17-20 and 24 is not patentable over Simone.


I write separately to emphasize that a reference may anticipate a claim if it discloses the claimed invention such that a skilled artisan could take its teachings and her own knowledge of the particular art to possess the invention. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (prior art reference disclosing a system for testing the integrity of electrical interconnections that did not specifically disclose simultaneous monitoring of output points still anticipated claimed invention if simultaneous monitoring is within the knowledge of a skilled artisan); In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (prior art anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings and his own knowledge to possess the claimed invention); In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 373-74 (C.C.P.A. 1962). Thus, the dispositive question here is whether the teachings of Simone placed a person of ordinary skill in the art in possession of a dried pet food product with a moisture content of less than 10% by weight.



Simone describes a pet food product that can have as little as about 10 weight percent moisture. As stated in the majority opinion, "the term 'about' as used in the about 10 percent disclosure of Simone would have been understood by one of ordinary skill in the art as a description that permits some variance both above and below an absolute value of 10 percent moisture levels in the pet chew". (Slip op., p. 13). Consequently, a skilled artisan could take Simone's teachings and his own knowledge to possess the claimed invention, such as, for example, a pet chew having a moisture level of 9.99%.

In light of the above, and the reasons presented in the majority opinion, I affirm the examiner's § 102(b) rejection of representative claim 1 over Simone.

Having determined that the subject matter of claims 1-3, 6, 7, 13-15, 17-20 and 24 is unpatentable over Simone, I do not believe it is necessary to further explore the suitability of rejecting these claims under § 103.



JEFFREY T. SMITH  
Administrative Patent Judge

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WALTZ, Administrative Patent Judge, dissenting:

I concur with the opinion of the majority that the rejection of claims 1, 13, 20 and 24 under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the application as filed should be affirmed (see pages 6-9 of this Decision). I also concur with Judge Kratz that a new ground of rejection should be entered for claims 1 through 24 under 35 U.S.C. § 103(a) over Simone, pursuant to the provisions of 37 CFR § 1.196(b) (*id.* at pages 15-23).

I write separately since I *dissent* from the opinion of the majority that the rejection of claims 1-3, 6, 7, 13-15, 17-20 and 24 under 35 U.S.C. § 102(b) as anticipated by Simone should be affirmed (Decision, pages 9-15; Concurring Opinion, pages 24-25). Based on the facts of this record, I would reverse the rejection under section 102(b) as anticipated by Simone (although I concur that the claims should be rejected under section 103(a) over Simone as outlined in the new ground of rejection under 37 CFR § 1.196(b)).

As stated on page 9 of this Decision, we limit our consideration in the rejection based on section 102(b) to claim 1 on appeal. The majority also states that the "pivotal issue" developed in this appeal for this section 102(b) rejection is

whether the disclosure in Simone of "about 10 to about 30 percent by weight moisture" (col. 5, ll. 65-68) would reasonably convey to one of ordinary skill in the art that Simone described or had possession of a pet chew that includes a moisture content of less than 10 weight percent as required by claim 1 on appeal (Decision, page 12). I believe that this issue is not the only issue in the section 102(b) rejection. Furthermore, I believe that this issue framed by the majority deals more with the "written description" requirement under section 112, first paragraph, than anticipation as set forth in our controlling case law.

I believe that the majority has not fully reviewed the issue of the moisture content taught by Simone, since there appears to be contradictory disclosures of a lower limit of "about 10" percent by weight and "about 12" percent by weight (Decision, page 14). Simone teaches that the final product contains water "at a concentration equal to or greater than 12% by weight" (col. 5, ll. 7-8). Simone also teaches that the extruded product is cut into discrete particles and then allowed to cool and dry "to adjust the moisture level to about 10 to about 30% by weight" (col. 5, ll. 54-68). Simone further teaches that the expanded cellular product as it leaves the extruder has a moisture content

"of about 10 to about 35% water by weight" (col. 7, ll. 18-21) while the cut and cooled extrudate is dried to a "moisture content of about 12 [sic, to] about 35% by weight water" (col. 7, ll. 22-28). The disclosure of Simone fails to teach how a product can leave the extruder at a lower moisture content ("about 10" percent) and be dried to a final product with a higher moisture content ("about 12" percent) (see also claims 1 and 7 in col. 10 of Simone, as well as claims 17 and 23 in cols. 11-12). Accordingly, it is not clear whether Simone reasonably conveys to one of ordinary skill in the art the description of a edible pet chew with a moisture content of "about 10" percent by weight.

With regard to the "pivotal issue" discussed above, I agree with the construction advanced by the majority that the term "about" as used in the disclosure of moisture content "permits some variance both above and below an absolute value of 10 percent moisture levels in the pet chew" (Decision, page 13). However, it must be noted that this construction is the same construction for the same term as set forth by our reviewing court in affirming a rejection based on *section 103* (as cited by the majority opinion at page 16). See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990) (concluding

that a claimed invention was rendered *obvious* by a prior art reference whose disclosed range was "about 1-5%" carbon monoxide whereas the claimed range was *more than* 5% to 25% carbon monoxide). The court in Woodruff did not make any rejection under section 102(b) or affirm the obviousness rejection by holding that anticipation is the ultimate or epitome of obviousness. Cf., In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

"[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account." Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985). "[I]t has long been held that the disclosure in the prior art of any value within a claimed range is an anticipation of the claimed range." In re Wertheim, 591 F.2d 257, 267, 191 USPQ 90, 100 (CCPA 1976). However, on the record of this appeal, the examiner (and the majority opinion) has not cited any specific embodiment or example where the moisture content of the pet chew falls within the claimed range. All the examiner (and the majority opinion) has found is that there is possible overlap between the moisture

content disclosed by Simone and the claimed moisture content range (Answer, paragraph bridging pages 4-5; Decision, pages 12-14).

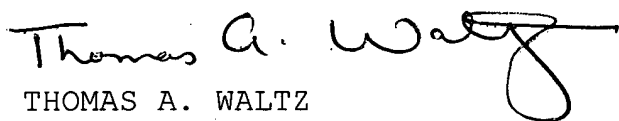
The mere existence of overlap at one point or overlapping ranges in the prior art does not *per se* provide a description of the claimed range within the meaning of section 102. In cases involving overlapping ranges, our reviewing and predecessor courts have consistently held that even a slight overlap in range establishes a *prima facie* case of *obviousness*, not anticipation. See In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) (acknowledging that a claimed invention was rendered *prima facie* obvious by a prior art reference whose disclosed range (50 to 100 Angstroms) overlapped the claimed range (100 to 600 Angstroms) at one point); In re Woodruff, *supra*; and In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974) (concluding that a claimed invention was rendered *prima facie* obvious by a prior art reference whose disclosed range (0.020-0.035% carbon) overlapped the claimed range (0.030-0.070% carbon)). In a most recent case, our reviewing court has stated that a *prima facie* case of obviousness exists even when the claimed ranges are completely encompassed by the prior art. See In re Petersen, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382

(Fed. Cir. 2003) ("A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art," with selection of a narrow range from a somewhat broader range disclosed in a prior art reference no less obvious than identifying a range that simply overlaps a disclosed range; in fact, when the claimed ranges are completely encompassed by the prior art, the conclusion of obviousness is even more compelling than in cases of mere overlap). Accordingly, the conclusion of obviousness for the "mere overlap" of the ranges of the prior art and the claims in this appeal is not even as compelling as when the prior art range encompasses the claimed range. If our reviewing court states that a range claimed that is *totally subsumed* by the range disclosed in the prior art provides only a more "compelling" conclusion of obviousness, I cannot agree with the majority opinion in this appeal that an overlapping range of the prior art with the claimed subject matter can, without more, describe a claimed invention within the meaning of section 102.

It must also be noted that the basis for the rejection has important consequences since the submission of unobvious or unexpected results is not relevant to a rejection based on section 102. See In re Malgari, supra. Therefore the majority

opinion would not allow appellants to present any objective evidence of unobviousness.

For the foregoing reasons, I would reverse the examiner's rejection of claims 1-3, 6, 7, 13-15, 17-20 and 24 under 35 U.S.C. § 102(b) as anticipated by Simone. Therefore I respectfully dissent from the majority opinion on this rejection.



THOMAS A. WALTZ  
Administrative Patent Judge

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Bell, Boyd & Lloyd LLC  
P.O. Box 1135  
Chicago, IL 60690-1135

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P.O. Box 1135  
Chicago, IL 60690-1135